



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/005,019	12/04/2001	Kirk Currie	33588.00014USPT	9709

7590 08/24/2004

Alan R. Thiele
JENKENS & GILCHRIST, P.C.
1445 Ross Avenue, Suite 3200
Dallas, TX 75202-2799

EXAMINER

LANEAU, RONALD

ART UNIT PAPER NUMBER

3627

DATE MAILED: 08/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/005,019

Applicant(s)

CURRIE ET AL.

Examiner

Ronald Laneau

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-7 are presented for examination.

Claim Rejections - 35 USC §101

2. Claim 1 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claim 1 only recites an abstract idea. The recited steps of merely customizing a putter to his/her physique and playing style at the point of purchase does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of how to sell a putter complete at point of purchase to a golfer.

Art Unit: 3627

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention adjust the lie angle and the loft angle of a putter (i.e., repeatable) used in providing the golfer with a selection of weights and instructing the golfer on how to mount a selected one of said individual weights (i.e., useful and tangible).

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claim 1 is deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grace (US 2003/0050131) in view of Mattson (US 5,997,409) and further in view of (Hamburger (US 6,641,487).

As per claims 1, 5 and 7, Grace teaches a method of selling a putter complete at point of purchase to a golfer (page 2, [0029], lines 1-4) comprising the steps of: (a) providing the golfer with instruction on how to select a putter from a group of putters having a variety of different hosel offsets (page 2, [0025], lines 1-10); (b) providing the golfer with a visual indication of whether the bottom of said selected putter is substantially parallel to a horizontal plane (see figs. 1-3, 12).

Art Unit: 3627

Grace does not teach adjusting the lie angle and the loft angle but Mattson teaches adjusting the lie angle (see abstract) so that the bottom of said selected putter is (ii) adjusting the loft angle so that the loft angle is approximately 3° (the adjustment can be any angle and that includes the 3° angle for the loft) from a vertical plane (col. 4, lines 26-29). Furthermore, Mattson's system must use some kinds of mechanism to allow the holding of the club head and the club bar as claimed.

Neither Grace nor Mattson expressly teach the selection of weights but Hamburger teaches (d) providing the golfer with a selection of weights, said selection of weights including individual weights constructed and arranged to be mountable to the bottom of the putter head; instructing the golfer on how to mount a selected one of said individual weights to the bottom of the putter head (col. 3, lines 5-14 and 27-31).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the adjustment of the lie and loft angles as taught by Mattson into the system of Grace because it would provide greater flexibility than previously achieved in standard golf club construction. It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the selection of individual weights constructed and arranged to be mountable to the bottom of the putter head as taught by Hamburger into the combined device of Grace and Mattson because it would provide different style of putter heads to accommodate the different consumer preferences.

As per claims 2 and 4, neither Grace nor Mattson not Hamburger teach the steps of repeating step (c)(i) and (c)(ii) until the feel of the putter is satisfactory to the golfer and the steps of determining the left/right aiming tendency of the golfer and providing the

Art Unit: 3627

golfer with advice on the type of offset needed to correct it. The examiner takes Official notice that it is only human to repeat certain steps until a player is satisfied with the result and advising a player on a particular deficiency in his game is well known because it would allow a golfer to feel more comfortable when putting and also maximize his performance for the game.

As per claims 3 and 6, Hamburger teaches a method wherein the group of putters having a variety of different hosel offset angles further includes putters having different head styles and different shaft lengths (col. 2, lines 6-14).

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Busnardo (US 5,863,257) teaches an adjustable golf putter that has an attachment means which allows the shaft to be removed from the putter head, and allows the angle between the golf club shaft and the golf club putter head to be adjusted.
- Reynolds, Jr. (US 5,746,664) teaches a golf club, such as a putter, that utilizes removable shafts, removable weights in the shaft grip end, a variable length adapter to connect the shaft to the putter head and vary the shaft end weight.
- Levocz et al (US 5,716,287) teach an adjustable golf putter having a shaft, a putter head and an angle adjusting adapter for adjusting the angle between the shaft and the putter head.
- Schmidt, Jr. et al (US 5,292,123) teach a golf club with a shaft angularly adjustable relative to the head through selected angles.

Art Unit: 3627

- Levocz et al (US 5,542,665) teach a golf putter having an elongated shaft and a putter head.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ronald Laneau whose telephone number is (703) 305-3973. The examiner can normally be reached on Mon-Fri from 8:30am - 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on (703) 308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ronald Laneau
Examiner
Art Unit 3627

Ronald Laneau 8/23/04
Primary Examiner

rl